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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,163	01/14/2002	Keiichi Sugiyama	F9597.0001/P001	5041

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DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP  
2101 L Street, NW  
Washington, DC 20037

EXAMINER

CHEN, TSE W

ART UNIT PAPER NUMBER

2116

DATE MAILED: 03/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/043,163

**Applicant(s)**

SUGIYAMA, KEIICHI

**Examiner**

Tse Chen

**Art Unit**

2116

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2,4,5,7,9,11,12 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,4,5,7,9,11,12 and 14-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. It is hereby acknowledged that the following papers have been received and placed of record in the file: Amendment dated February 4, 2005.
2. Claims 2, 4-5, 7, 9, 11-12, 14-16 are presented for examination. Applicant has canceled claims 1, 3, 6, 8, 10, 13.

#### ***Claim Objections***

3. Claim 2 is objected to because of the following informalities: "An information processing apparatus, the information processing apparatus having a first operating system..." is redundant and should be "An information processing apparatus having a first operating system..." Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant did not disclose the subject matter of "a detecting routine that *automatically* detects whether an external storage device is connected to the interface". Therefore, said subject matter is considered new and is not eligible for prosecution in this application. However, in the interest of compact prosecution, references have been applied in the rejections detailed below.

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 4-5, 7, 9, 11-12, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gallagher et al., US Patent 6523112, hereinafter Gallagher, in view of Itoh et al., US Patent 6795912, hereinafter Itoh.

8. In re claim 2, Gallagher discloses an information processing apparatus [processing unit module 28] comprising:

- An interface [fwd scsi 16].
- A storage device [rom] which stores a program, said program comprising:
  - A detecting routine that automatically detects [via sequential search] whether or not an external device [e.g., hard drive of the storage system 12] is connected to said interface [col.19, 1.8 – col.20, 1.15].
  - A judgment routine [e.g., 402] that determines whether the external device is an external storage device that stores an [second] operating system [col.19, 1.37 – col.20, 1.15].
  - A starting-up routine [e.g., 404] that starts up the [second] operating system [col.19, 1.37 – col.20, 1.15].

9. Gallagher did not disclose explicitly another operating system.

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10. Itoh discloses an information processing apparatus [computer system 10] having a first operating system [first os], the apparatus comprising:

- A program comprising a stopping routine [os termination hook] that stops start-up of the first operating system [first os] before the second operating system [second os] is started up by the starting up routine [col.3, l.60 – col.4, l.14; col.12, ll.7-46; col.17, l.44 – col.18, l.14].

11. It would have been obvious to one of ordinary skill in the art, having the teachings of Gallagher and Itoh before him at the time the invention was made, to modify the apparatus taught by Gallagher to include the teachings of Itoh, in order to obtain the information processing apparatus wherein said program comprises a stopping routine which stops start-up of the first operating system before the second operating system is started up by the starting up routine. One of ordinary skill in the art would have been motivated to make such a combination as it provides a versatile way to switch between operating systems under different environments [Itoh: col.1, ll.18-28; col.2, ll.32-42; multiple different operating systems are required in order to operate under different environments].

12. As to claim 4, Gallagher discloses the information processing apparatus wherein the program is an input/output program [col.19, l.8 – col.20, l.15; program utilizes input/output routines to send and receive request/information regarding os].

13. As to claims 5 and 7, Itoh discloses the information processing apparatus wherein the starting-up routine starts up the first operating system [first os] after the operation of the second operating system [second os] is completed [col.17, ll.35-43].

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14. As to claims 9, 11-12, and 14, Itoh discloses the information processing apparatus wherein an external storage device [tablet] is connected to the interface via an interface cable [usb 44] which allows a live line to be inserted and to be removed [col.8, ll.43-55].

15. In re claim 15, Gallagher and Itoh disclose each and every limitation of the claim as discussed above in reference to claim 1. Gallagher and Itoh disclose the information processing apparatus; therefore, Gallagher and Itoh disclose the method of utilizing the information processing apparatus.

16. In re claim 16, Gallagher and Itoh disclose each and every limitation of the claim as discussed above in reference to claim 1. Gallagher discloses the program for the information processing apparatus [col.19, l.8 – col.20, l.15].

#### ***Response to Arguments***

17. All rejections of claim limitations as filed prior to Amendment dated February 4, 2005 not argued in entirety or substantively in response filed as said Amendment have been conceded by Applicant and the rejections are maintained from henceforth.

18. Applicant's amended claims 2, 5, and 7 with respect to the objections of informalities in the previous Office Action have been fully considered. The objections of the claims have been withdrawn.

19. Applicant's amended title with respect to the objection of the title in the previous Office Action has been fully considered. The objection of the title has been withdrawn. However, Examiner reserves the right to change the title under MPEP 606.01.

20. Applicant's arguments, with respect to the teachings of Gallagher and Itoh have been fully considered but they are not persuasive. Applicant alleges that Gallagher "does not show a

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second operating system. Thus, no one at the time of the invention would have used Itoh to show stopping the starting-up of a second operating system.” Firstly, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to include a very well known second operating system is clearly cited in Itoh [col.1, ll.18-28] as a way to provide the flexibility of operating under different environments. Secondly, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### ***Conclusion***

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tse Chen whose telephone number is (571) 272-3672. The examiner can normally be reached on Monday - Friday 9AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne can be reached on (571) 272-3670. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tse Chen  
March 9, 2005

  
**LYNNE H. BROWNE**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**